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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,267	03/18/2004	Paul E. Denney	LOMASR.026CP1	5395

20995 7590 03/29/2007  
KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER
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EVANS, FANNIE L

ART UNIT	PAPER NUMBER
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2877

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/29/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/29/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

**Office Action Summary**

Application No.

10/803,267

Applicant(s)

DENNEY ET AL

Examiner

F. L. Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 9-15 and 19-21 is/are allowed.
- 6) ☒ Claim(s) 7, 8 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***The Terminal Disclaimer***

The terminal disclaimer filed on January 16, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent Application No. 10/691,444 has been reviewed and is accepted. The terminal disclaimer has been recorded. The terminal disclaimer overcomes the provisional double patenting rejection set forth in the previous Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 8 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure of the invention is silent with respect to the collection lens being coaxial with the laser light impinging on the interaction region and the collection lens being off-axis with the laser light impinging on the interaction region, as set forth in amended claims 7 and 8, respectively. Paragraph [0168] in the specification specifies that it is the collimating lens that can be located coaxial and off-axis of the laser light/beam. Amended claims 7 and 8 introduce new matter into the disclosure of the invention. Applicant is required to cancel the new matter in the response to this Office action.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 16-18 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to a judicial exception, an abstract idea; as such, pursuant to the Interim Guidelines on Patent Eligible Subject Matter (MPEP 2106), the claims must have either physical transformation and/or a useful, concrete and tangible result. The claims fail to include transformation from one physical state to another. Although, the claims appear useful and concrete, there does not appear to be a tangible result claimed. Merely analyzing a portion of the spectrum (lines 8 and 9 of independent claim 16) would not appear to be sufficient to constitute a tangible result, since the outcome of the analyzing step has not been used in a disclosed practical application nor made available in such a manner that its usefulness in a disclosed practical application can be realized. As such, the subject matter of the claims is not patent eligible.

Attention is directed to section IV. of MPEP 2106, "DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. SEC. 101." In part C.2.(2), "Practical Application That Produces a Useful, Concrete, and Tangible Result", the second and third sentences state 'If USPTO personnel determine that the claim does not entail the transformation of an article, then USPTO personnel shall review the claim to determine if it produces a useful, tangible, and concrete result. In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is "useful, tangible, and concrete."'

The dependent claims do not appear to add any real world application required by MPEP 2106.

#### *Response to Arguments*

Applicant's arguments with respect to the rejection of claims 7 and 8 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to the rejection of claims 15 and 16 under 35 U.S.C. § 102(b)

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have been fully considered and are persuasive. The rejection of the claims has been withdrawn.

Applicant's arguments with respect to the rejection of claims 1-5 and 9-14 under 35 U.S.C. § 103(a) have been fully considered and are persuasive. The rejection of the claims has been withdrawn.

Applicant's arguments with respect to the rejection of claim 16 under 35 U.S.C. § 101 have been fully considered but they are not persuasive.

Contrary to applicant's assertion in the first paragraph on page 8 of the response filed on January 16, 2007, the invention set forth in independent claim 16 does not set forth a tangible result. The final result of the method of claim 16 is the step of analyzing at least a portion of the spectrum for indications of the exposed embedded object. The analyzing step is merely data manipulation performed by a computer. For example, see lines 1-3 in paragraph [0173] in the specification. The analyzing step is not a tangible (real world) result. The claim fails to set forth a step of using the result of the analysis in the real world to achieve a tangible result.

#### *Allowable Subject Matter*

Claims 1-6, 9-15 and 19-21 are allowed over the prior art of record.

As to independent claim 1, the prior art of record, taken alone or in combination, fails to disclose or render obvious for the reasons set forth in the first paragraph on page 11 of applicant's response.

As to independent claim 15, the prior art of record, taken alone or in combination, fails to disclose or render obvious for the reasons set forth the second paragraph on page 9 of applicant's response.

As to independent claim 19, the prior art of record, taken alone or in combination, fails to disclose or render obvious a method of detecting an embedded material within a laser-irradiated interaction region of a structure comprising the step of avoiding irradiation of the interaction region when the indications of the embedded material are detected, in combination with the rest of the limitations of the claim.

#### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office

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action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Fax/Telephone Numbers***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner whose telephone number is (571) 272-2414.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on (571) 272-2800 ext 77. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**F. L. EVANS**  
**PRIMARY EXAMINER**  
**ART UNIT 2877**

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March 21, 2007